



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/715,408

11/19/2003

Mark Meister

3222.1320001

5313

26111

7590

08/19/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LIM, KRISNA

ART UNIT

PAPER NUMBER

2453

MAIL DATE

DELIVERY MODE

08/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,408	Applicant(s) MEISTER ET AL.	
	Examiner Krisna Lim	Art Unit 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 23-27 and 29-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 23-27 and 29-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2453

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/06/09 has been entered.

Claims 1-13, 23-27 and 29 are still pending for examination. Claims 30-53 are newly added for examination. Claims 14-22 and 28 were canceled.

2. The amendment filed 7/6/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. The 35 U.S.C. § 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a) The send function is initiated by an unauthorized agent is not even clearly mentioned in the original specification.

b) The unauthorized agent is the virus is not even clearly mentioned in the original specification.

c) "Recognizing that an unauthorized electronic mail message is about to be sent comprises detecting that a send function has initiated by an unauthorized agent" is not clearly mentioned in the original specification.

d) "A computer readable storage medium having stored thereon, computer executable instructions that, if executed by a computing device, cause the computing device to perform a method" is not even clearly mentioned in the original specification.

e) "A computer readable medium having stored thereon, computer executable instructions that, if executed by a computing device, cause the computing device to perform a method" is not even clearly mentioned in the original specification.

f) "The unauthorized electronic mail is composed by a virus and has a valid recipient address" is not even clearly mentioned in the original specification.

g) "Recognizing that an unauthorized electronic mail message is about to be sent includes detecting that a send operation has been initiated" is not even clearly mentioned in the original specification.

h) The newly added language to the specification in paragraphs [0016.1] to [0016.4] introduces new matter into the specification, for the example, the newly added language of "the recognizing process recognizes a send operation initiated by an unauthorized agent", "recognizing that a message is to be sent by an unauthorized agent", "recognizing whether an electronic mail message is to be sent by a user or an unauthorized agent" and "determining whether an electronic mail message is to be sent by detecting a send operation initiated by the user or detecting a send operation initiated by an unauthorized agent."

Applicant is required to cancel the new matter in the reply to this Office Action.

If the applicant disagrees with the above objection, the applicant is requested to cite the exact claimed language in the original specification, not the newly added specification. Examiner disagrees that the original specification in paragraphs [0024] to [0026] contains the exact newly added claimed language.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying

Art Unit: 2453

out his invention.

4. Claims 1-13, 23-27 and 30-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation to the claims does not even mention or support in the original specification including the material from the parent application 09/337,035. The following limitations does not fully described in the original specification:

a) The send function is initiated by an unauthorized agent is not even clearly mentioned in the original specification.

b) The unauthorized agent is the virus is not even clearly mentioned in the original specification.

c) "Recognizing that an unauthorized electronic mail message is about to be sent comprises detecting that a send function has initiated by an unauthorized agent" is not clearly mentioned in the original specification.

d) "A computer readable storage medium having stored thereon, computer executable instructions that, if executed by a computing device, cause the computing device to perform a method" is not even clearly mentioned in the original specification.

e) "A computer readable medium having stored thereon, computer executable instructions that, if executed by a computing device, cause the computing device to perform a method" is not even clearly mentioned in the original specification.

f) "The unauthorized electronic mail is composed by a virus and has a valid recipient address" is not even clearly mentioned in the original specification.

g) "Recognizing that an unauthorized electronic mail message is about to be sent includes detecting that a send operation has been initiated" is not even clearly mentioned in the original specification.

If the applicant disagrees with the above objection, the applicant is requested to cite the exact claimed language in the original specification, not the newly added specification. Examiner disagrees that the original specification in paragraphs [0024] to [0026] contains the exact newly added claimed language.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Art Unit: 2453

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

August 14, 2009

/Krisna Lim/
Primary Examiner, Art Unit 2453